

Appl. Ser. No. 09/913,005

Att. Docket No. 10191/1961

Reply to Final Office Action of November 7, 2003

REMARKS

Claims 13, 18, 23, 28, 33 and 52 are canceled without prejudice, and therefore claims 14 to 17, 19 to 22, 24 to 27, 29 to 32 and 34 to 51 are now pending.

With respect to paragraph three (3) of the Final Office Action, Applicants thank the Examiner for allowing claims 14 to 17, 19 to 22, 24 to 27, 29 to 32, 34 to 37 and 39 to 52. As to claim 38 it should be allowed since it depends from claim allowable claim 34. As to claim 52, it is being canceled without prejudice, since it depends from rejected and canceled claim 33.

With respect to paragraph two (2), claims 13, 18, 23, 28, 33 and 38 were rejected under 35 U.S.C. § 102(b) as anticipated by Zeller et al., U.S. Patent No. 6,073,740.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). For the reasons explained in the prior Amendment, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with in view of the foregoing, to facilitate matters, claims 13, 18, 23, 28 and 33 have been canceled without prejudice. As to claim 38, it is allowable, since it depends from allowed claim 34 (and not rejected and canceled claim 33). It is therefore respectfully requested that the rejections be withdrawn since claims 13,

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18, 23, 28 and 33 are canceled, and since claim 38 is allowable since it depends from allowed claim 34.

It is therefore respectfully submitted that claim 38 is allowable, like allowed claims 14 to 17, 19 to 22, 24 to 27, 29 to 32, 34 to 37 and 39 to 51.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claim 38 is allowable, like allowed claims 14 to 17, 19 to 22, 24 to 27, 29 to 32, 34 to 37 and 39 to 51. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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